

REMARKS

This amendment is submitted along with a Request for Continued Examination and appropriate fee in reply to the Office Action dated April 16, 2008. Claims 11-13 and 16-19 currently stand rejected. Independent claims 11 and 12 have been amended for clarity. No new matter has been added by the amendment

In light of the amendments and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 U.S.C. §103

Claims 11-13 and 16-19 currently stand rejected under 35 U.S.C. §103(a), as being unpatentable over Hale et al. (U.S. Patent No. 6,732,180, hereinafter "Hale") in view of Rabin et al. (U.S. Patent No. 6,697,948, hereinafter "Rabin") and further in view of Cooper et al. (U.S. Patent Application Publication No. 2001/0051996, hereinafter "Cooper").

Independent claims 11 and 12 have been amended to recite, *inter alia*, comparing a plurality of digital music files on the basis of file name, file size and file playing time. None of Hale, Cooper and Rabin provide any disclosure related to comparing files based on the file name, file size and file playing time. Accordingly, any combination of Hale, Cooper and Rabin also fails to teach or suggest the above recited feature. Thus, claims 11 and 12 are patentable over the cited references, alone or in combination.

Furthermore, independent claims 11 and 12 also recite, determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network. The Office Action admits, and Applicants agree, that neither Hale nor Rabin provides any teaching or suggestion regarding determining which music files have a high probability of being copied. Accordingly, the Office Action relies upon Cooper for disclosing such feature. Applicants respectfully disagree.

In this regard, the Office Action cites paragraphs [0074] to [0077] of Cooper as disclosing the above recited feature. However, the cited paragraphs of Cooper merely relate to a system for authenticating the validity of digital certificate IDs associated with downloaded files.

In this regard, Cooper describes efforts to match the digital certificate on a device to digital certificate ID numbers. If no match can be made a counter will accumulate and, if a threshold count is reached, a letter will be sent to the owner of the digital certificate. There is no indication in the cited passage or any part of Cooper that such a count is associated with determining a file with a higher probability of being reproduced by another user than other music files. To the contrary, the above described mechanism operates for all downloaded files that have a particular marking thereon. The marked files are also not disclosed as having any relationship to any determination regarding a digital music file that has a higher probability of being reproduced.

Of note, Cooper does disclose in paragraph [0073] that only certain content files may be downloaded by an ALAM module. The certain files may be “files that are determined to have a high probability of being in a place that is not approved by the right owner”. Thus, the probability determination that is disclosed in Cooper is associated with whether or not a file is in a location that is unapproved and has no relationship to determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication as recited in independent claims 11 and 12. Moreover, if the file is in a place not approved by the right owner, the probability of Cooper relates to a probability that the file has already been illegally reproduced and has no relationship to any future action associated with the file. Thus, Cooper also fails to teach or suggest the above recited feature.

Since Cooper, Hale and Rabin all fail to teach or suggest determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication as recited in independent claims 11 and 12, any combination of Cooper, Hale and Rabin also fails to teach or suggest such feature. Thus, independent claims 11 and 12 are patentable over Cooper, Hale and Rabin, alone or in combination. Claims 13 and 16-19 are therefore also patentable over Cooper, Hale and Rabin, alone or in combination, due to their dependency from independent claims 11 and 12.

Notably, however, there are yet further reasons for the patentability of at least some of the dependent claims. In this regard, for example, claims 18 and 19 further define that

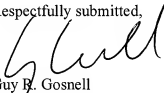
determining a file having a higher probability of being reproduced includes selecting one digital music file among a plurality of digital music files such that the identified digital music file is selected based on having a greater number of other digital music files having two or more of a same name, size and playing time as the identified digital music file than other music files related to the digital music file illegally distributed through the computer communication network. None of Hale, Cooper and Rabin includes any disclosure regarding selecting files that have at least two of the same name, size and playing time. Thus, claims 18 and 19 are also patentably distinct from the cited references, alone or in combination.

Accordingly, for all the reasons above, Applicants respectfully submit that the rejections of claims 11-13 and 16-19 are overcome.

CONCLUSION

In view of the amendments and the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application. It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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LEGAL01/13093613v1